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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,783	05/24/1999	HANS-JURGEN FISCHER	10191/913	3361
26646	7590	08/08/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			HAVAN, THU THAO	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 08/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/202,783

Applicant(s)

FISCHER ET AL.

Examiner

Thu Thao Havan

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5/22/06.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8,9 and 11-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 8,9 and 11-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 8-9 and 11-17 are pending. This action is in response to the amendment received May 22, 2006.

### ***Response to Arguments***

The rejection of claims 8-9 and 11-17 under 35 U.S.C. 103(a) as being unpatentable by Chaum et al. (US 5,485,520) and Hoshino (US 6,073,062) is maintained.

Upon a closer examination, Applicant's arguments filed May 22, 2006 have been fully considered but they are not persuasive.

In response to the arguments concerning the previously rejected claims the following comments are made:

A.) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Chaum and Hoshino teach mobile terminal with automatic real-time highway toll collection.

Art Unit: 3624

B.) Applicant alleges that the prior art made of record fails to teach one data word constantly changing. The examiner disagrees with applicant's representative since Hoshino teaches one data word constantly changing when he discloses instruction data that is constantly changeable from the mobile terminal (col. 10, line 57 to col. 11, line 14; col. 14, lines 21-29; col. 23, line 34 to col. 25, line 38; col. 33, lines 39-51; figs. 24-27).

The instruction data corresponds to one (first) data word and second data word wherein the data is changed based on the conditions of the vehicle.

C.) Applicant alleges that the prior art made of record fails to teach integrated circuit card to the terminal. The examiner disagrees with applicant's representative since Chaum teaches integrated circuit card to the terminal when he discloses application specific integrated circuit (col. 12, line 4 to col. 14, line 31; fig. 3a). His system integrates, adapts and improves the prior Amtech and DigiCash technologies so as to achieve a smart card-based road pricing system complete with bi-directional microwave communication link. For example, many of the IVU and/or RCS circuits could advantageously be simplified and/or further integrated in a commercialized embodiment of this invention as disclosed by Chaum.

D.) Applicant alleges that the prior art made of record fails to teach an identifier. The examiner disagrees with applicant's representative since Chaum teaches an identifier when he discloses a vehicle-owner identity code (col. 22, lines 45-58; col. 24; col. 3, lines 10-46; figs. 5a-5d). Chaum discloses a transaction identity code for authenticating and linking subsequent phases of the toll collection transaction. When an IVU comes within the communication "footprint" of an RCS (i.e., the highway area in which reliable

communication with an IVU is possible, or in otherwards, the microwave communication zone), this pre-configured "commit" data package is immediately and repetitively transmitted in an up-link mode to the nearest RCS at a toll plaza.

With regards to the claims rejected as taught by Chaum and Hoshino, the examiner would like to point out that the references teach the claimed limitations and thus provides adequate support for the claimed limitations. Therefore, the examiner maintains that Chaum and Hoshino taught the claimed limitations.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

TTH  
7/27/2006



VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3624